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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBYN R. LEVINE

Appeal 2009-010049
Application 09/761,121
Technology Center 3600

Decided: February 17, 2010

Before, ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
MURRIEL E. CRAWFORD, and JOSEPH A. FISCHETTI *Administrative Patent*
Judges.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-9, 12-18, 20-23. We have jurisdiction under 35 U.S.C. § 6(b).

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(2002). This appeal arises from the Examiner's Final Rejection, mailed November 16, 2005. The Appellant filed an Appeal Brief in support of the appeal on December 18, 2006. A Supplemental Examiner's Answer to the Appeal Brief was mailed on December 9, 2008. A Reply Brief was filed on February 6, 2009.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant claims a computer program product for instructing a processor to optimize the value of information presented to a customer through a marketing, transactional, informational, or outreach channel. (Specification 1:4-6).

Claim 23, reproduced below, is representative of the subject matter on appeal.

23. A computer program product for instructing a processor to provide a web site accessible by a user having a point of contact device, said computer program product comprising:

- means for determining said point of contact device of said user;
- means for retrieving a profiled past of said user including purchased data which is grouped or keyed to presenting a lifestyle or lifestage view of said user;
- means for retrieving current actions; and

wherein said computer program product is adapted for delivering web site content personalized to said user as an opportunity by creating a vision of a supplier's core competencies based on said point of contact device and said profiled past and said current actions, and developing said opportunity consistent with said vision by merging together and optimizing said vision with said supplier's channel awareness.

DISPOSITION OF THE APPEAL

The Examiner entered a new ground of rejection in the Supplemental Examiner's Answer dated December 9, 2008, against claims 1-9, 12-18 and 20 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. (Ans. 2-3). The Examiner properly gave notice of the new ground of rejection (Ans. 2-3) and the Technology Center Director approved it (Ans. 10-11). As the Answer indicated (Ans. 10), the Appellant was required to respond to the new ground within two months in either of two ways: 1) reopen prosecution (*see* 37 C.F.R. § 41.39(a)(2)(b)(1)); or 2) maintain the appeal by filing a reply brief as set forth in 37 C.F.R. § 41.41 (*see* 37 CFR 41.39(a)(2)(b)(2)), "to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection." (Ans. 10-11).

In response, Appellant's Reply Brief states: "Appellant therefore concedes the rejection of claims 1-9, 12-18, and 20 under this new ground of rejection and respectfully requests the Board to consider her arguments for allowance of claims 21-23." Accordingly, the appeal as to claims 1-9, 12-18, and 20, subject to the new ground of rejection under § 101 as being directed to nonstatutory subject matter, stands dismissed.

Upon return of the application to the Examiner, the Examiner should (1) cancel claims 1-9, 12-18, and 20 subject to the new ground of rejection and (2) notify the Appellant that the appeal as to 1-9, 12-18, and 20, subject to the new ground of rejection under §101, as being directed to nonstatutory subject matter, is

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dismissed and claims 1-9, 12-18, and 20 are cancelled. *See* Manual of Patent Examining Procedure (MPEP) § 1207.03, 8th ed., Rev. 7, Jul. 2008.

Given that the appeal as to claims 1-9, 12-18, and 20 stands dismissed, the rejections before us for review are reduced to as follows:

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Roberts	US 6,101,486	Aug. 8, 2000
Lee	US 6,829,475	Dec. 7, 2004

The following rejection is before us for review.

The Examiner rejected claims 20-23 under 35 U.S.C. § 102(e) as being anticipated by Roberts.

ISSUE

Has Appellant shown that the Examiner erred in rejecting claims 20-23 on appeal as being anticipated 35 U.S.C. § 102 (e) on the grounds that content, be it purchased or self-generated, remains non-functional descriptive material because it bears no functional relationship to its substrate and thus is given no patentable weight?

PRINCIPLES OF LAW

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

Novelty/Obviousness Nonfunctional Descriptive Material

When “non-functional descriptive material” is recorded or stored in a memory or other medium (i.e., substrate) it is treated as analogous to printed matter cases where what is printed on a substrate bears no functional relationship to the substrate and is given no patentable weight. *See In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983).

Nonfunctional descriptive material cannot render nonobvious in an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). *See also Ex parte Mathias*, 84

USPQ2d 1276 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1103; affirmed without written opinion Aug. 17, 2006).

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Roberts discloses that

... profile information may include any number of identifying characteristics, such as a customer name, address, company affiliation, e-mail address, phone number, customer account information, fax number, etc. In addition, the customer profile information may include other useful data, such as previous purchases and a listing of products and services currently owned by the customer. The products owned may be directly entered into the profile or may be products ordered by the company, and therefore recorded or logged into the company's database. Further, the profile information includes any product selections the customer makes while visiting the website. (col. 4, ll. 32-43)

2. The Examiner found that Roberts discloses purchased data in the form of: *“previous purchases and a listing of products and services currently owned, and the products owned are directly entered into the profile. Robert further teaches the profile information includes any product selections the customer makes while visiting the website and any specialized or customized features desired by the customer are also included in the profile information (see col. 4 lines 24-67).”* (Answer 7)

3. The Specification describes purchased data in the context of: “The profiled past of step 14 may also comprise retrieving purchased data whether or not a part of the demographic profile 26 or any other profile. Various firms provide data for purchase....” (Specification 12:1-3)

4. The Specification describes that demographic data profile information “may include ethnicity, block group, lifestyle, lifestage, income, and education data.” (Specification 11: 1-3)

5. The Examiner found based on (FF 1, 2) “... Roberts teaches delivering an opportunity to user based on past profile including purchased data and point of contact constraints, and current action, same as applicant's disclosed invention.” (Answer 9)

ANALYSIS

We affirm the rejection of claims 21-23 under 35 U.S.C. § 102 (e).

Initially, we note that Appellant argues these claims together as a group. Correspondingly, we select representative claim 21 to decide the appeal of these claims, remaining claims 22-23 standing or falling with claim 21.

Appellant argues error in the 35 U.S.C. § 102 (e) rejection based on Roberts because the Examiner has confused the claimed “*purchased* data” with the disclosed “purchase data” of Roberts. (Appeal Br. 7-8; Reply Brief 2)

The Examiner found that Roberts discloses purchased information in that some of the disclosed information gathered by the user profile is related to user purchases, e.g., previous purchases and a listing of products and services currently

owned. (FF 1, 2).

The Specification describes purchase information as information which various firms provide for purchase (FF 3).

While we find that the Examiner's interpretation of the disclosed purchase information of Roberts falls short of being purchased information, we nevertheless find that such a limitation is drawn to non-functional descriptive material which cannot distinguish the claims from the prior art. That is, claim 21 is drawn to a storage medium, an article of manufacture which does not change with the change in data held by it. Appellant has not established any new and unobvious functional relationship between the descriptive material and the substrate, e.g., storage medium. We thus find that no patentable weight in the descriptive material, and hence no error in the 35 U.S.C. § 102(e) rejection based on that distinction. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994).

Appellant next argues that the independent claims "...require[] in the fourth step, a vision of a supplier's core competencies be created based on the constraints, profiled past, and current actions recited in the first three steps. Roberts is incapable of creating such a vision because as stated above, Roberts does not describe all of the requirements of the second step on which the vision must be based." (Appeal Br. 8)

We are not persuaded by Appellant's argument here because it in effect raises the same content argument (Appeal Br. 7-8; Reply Brief 2) which we have addressed above and found unpersuasive.

We are also not persuaded by Appellant's argument that Roberts fails to

disclose a vision that needs to “be developed by merging together and optimizing this vision with this same supplier's channel awareness.” (Appeal Br. 8) This is because the Examiner found that “... Roberts teaches delivering an opportunity to user based on past profile including purchased data and point of contact constraints, and current action, same as applicant's disclosed invention.” (FF 5) Appellant does not contest the process of delivering an opportunity in Roberts, but rather only contests the resulting content in the vision, e.g., the supplier’s channel awareness, which again cannot serve to distinguish over the prior art.

CONCLUSIONS OF LAW

We conclude Appellant has not shown that the Examiner erred in rejecting claims 21-23 under 35 U.S.C. § 102(e) as being anticipated by Roberts.

DECISION

1. The decision of the Examiner to reject claims 21-23 is **AFFIRMED**.
2. Upon return of the application to the Examiner, the Examiner should (1) cancel claims 1-9, 12-18, and 20 subject to the new ground of rejection and (2) notify the Appellant that the appeal as to these claims, subject to the new ground of rejection under § 101, as being directed to nonstatutory subject matter, is dismissed and claims 1-9, 12-18, and 20 are cancelled. *See* Manual of Patent Examining Procedure (MPEP) § 1207.03, 8th ed., Rev. 7, Jul. 2008.

AFFIRMED

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